

REMARKS

This is in response to the Office Action mailed September 19, 2007.

Independent claim 1 and its dependent claims 2-7 and 11-14 and independent claim 8 and its dependents 9-10 and 15-18 are pending in this application. Claim 1 has been amended. Support for this amendment can be found throughout the originally filed application, e.g., paragraphs 0025 and 0026. No new matter is introduced. Applicants submit this amendment to place the claims in condition for allowance or better condition for Appeal pursuant to 37 C.F.R. § 1.116. Accordingly entry of this amendment is respectfully requested.

Claim Rejections – 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-7 and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Metz et al. (AJH 1:58-60 1988). The Examiner asserts that, though Metz requires sodium as well as calcium, “applicants do not exclude sodium.” Claim 1 has been amended to state that the benefit is “attributable to the calcium.” The claims thus exclude the attribution of weight loss to sodium. Metz does not disclose, teach or suggest a benefit attributable to calcium. Instead, Metz’ hypothesis and results suggest that the induction of weight loss is attributable to the simultaneous administration of calcium and sodium. In fact, Metz suggests that calcium alone is insufficient to reduce body weight, and that high sodium is required with calcium.

Metz does not teach inducing a weight benefit attributable just to calcium. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 102(b)

The Examiner has rejected claims 8-10 and 16-18 under 35 U.S.C. § 102(b) as being unpatentable over Schroeder et al. (U.S. Patent No. 4,027,043). Applicants traverse because Schroeder fails to disclose, either expressly or inherently, every element of the claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In order to anticipate, the elements of the prior art must be present and arranged as required by the claim. MPEP § 2131.

The Examiner acknowledges that Schroeder fails to disclose each and every element of the claims. Regarding Schroeder’s failure to disclose a dietary plan and a description, the

Examiner asserts that “applicants’ plan and description are merely an intended use.” The Examiner also contends that “the claimed pet food” of claim 9 is an intended use. The Examiner argues that “[a]n intended use is not considered a patentable limitation during prosecution of composition claims before the PTO.” Applicants disagree with both the Examiner’s characterization of the dietary plan, description and pet food as intended uses and the proposition that an intended use cannot be considered a patentable limitation.

The dietary plan and the description cannot be considered intended uses. The dietary plan and description are structural components of the animal food package which are functionally and integrally related to the claimed product, and the content of which distinguish the claimed product from the prior art. They are physical objects that are either present or absent in a device.

In addition, Applicants dispute the validity of the Examiner’s statement that “[a]n intended use is not considered a patentable limitation during prosecution of composition claims before the PTO.” The Examiner does not offer any authority, and Applicants have found none. In fact, contrary to the Examiner’s contention, the MPEP states that an intended use must be construed as a claim element so long as the language does not merely suggest or make optional a structural element or a step to be performed. § 2106. Claim 8 plainly recites an animal food package comprising, *inter alia*, a dietary plan and a description. The language cannot be construed to make the dietary plan or the description optional elements of the claims. Thus, the dietary plan and the description must be considered elements of the claim.

Because, as the Examiner acknowledges, Schroeder does not disclose the dietary plan or the description, either expressly or inherently, Schroeder cannot anticipate claims 8-10 and 16-18. Thus, the rejection must be withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims 1-18 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 22-0261.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By _____
Michael A. Golin

Registration No.: 31,957
Zayd Alathari
Registration No.: 42,256
VENABLE LLP
P.O. Box 34385
Washington, DC 20043-9998
(202) 344-4000
(202) 344-8300 (Fax)
Attorney/Agent For Applicant

DC2/920862